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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,552	01/26/1999	WATARU TOMIDA	102654	1322

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EXAMINER	
POKRZYWA, JOSEPH R	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/236,552	TOMIDA, WATARU	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-16,18,19,21 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-16,18,19,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/03 has been entered.

Response to Amendment

2. Applicant's amendment received on 9/24/03 has been entered and made of record. Currently, **claims 14-16, 18, 19, 21, and 22** are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 14-16, 18, 19, 21, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (U.S. Patent Number 6,384,927) in view of Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 6/3/03).

Regarding ***claim 14***, Mori discloses an internet facsimile device (see Figs. 1 and 2, FI1, and FI2) of a receiving party (see Fig. 1, 9, 19, and 24) comprising means for receiving by the internet facsimile device via an internet at least one set of electronic mail data (see Figs. 4A , 4B, and 17) attached with an electronic mail title (being the "Subject" field), means (system controller 1) for reading the electronic mail title (steps 402, 903, 1203, in Figs. 9, 19, and 24, respectively, being read in column 14, lines 38 through 45, column 20, lines 62 through 67, and column 23, lines 13 through 18), means for displaying data (display part 7, column 9, line 58 through column 10, line 24), a means for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (steps 404, 905, and 1205 in Figs. 9, 19, and 24, respectively), means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (being when "000" is set in the "Subject" field, column 19, line 43 through column 20, line 6), and means for forming an image based on electronic mail data selected by the data selecting means (column 14, lines 44 through 50, column 21, lines 1 through 6, and column 23, lines 13 through 24), wherein the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 14, lines 44 through 50, column 21, lines 1 through 6, and column 23, lines 13 through 24), whereby the internet facsimile device prints the image formed by the image forming means automatically without any instructions from a user (steps 406, 907, and 1207 in Figs. 9, 19, and 24, respectively).

Continuing, Mori teaches that the "Subject" is normally used to display a title (as read in column 19, lines 43 through 54), but Mori fails to specifically teach if the display part 7 actually does display the electronic mail title that has been received along with the electronic mail data.

Cooper discloses an internet facsimile device (see Fig. 1, column 6, lines 30 through 65) of a receiving party comprising means for receiving by the internet facsimile device via an internet at least one set of electronic mail data (column 6, lines 30 through 14) attached with an electronic mail title (see Fig. 4, being included in the header of the message, column 9, lines 7 through 39), means for reading the electronic mail title (column 6, lines 30 through 42), *means (display 16) for displaying the electronic mail title that has been received along with the electronic mail data (column 7, lines 1 through 53, seen in Fig. 4)*, means for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 7, lines 15 through 34), means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (column 6, lines 16 through 42), and means for forming an image based on electronic mail data selected by the data selecting means (column 7, lines 20 through 53), *wherein the internet facsimile device displays the received electronic mail title (see Fig. 4, column 9, lines 7 through 49)*, and wherein the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 6, line 30 through column 7, line 53), whereby the internet facsimile device prints the image formed by the image forming means (via printer 36, seen in Fig. 1, column 7, lines 28 through 41). Therefore, it would have been obvious to a person of ordinary skill in the art at the invention was made to include the teachings of Cooper in the system of Mori. Mori's system would become more user-friendly with the addition of Cooper's teachings, as an operator or user would be able to see and review messages, and specifically to view the subject of the received messages.

Regarding ***claim 15***, Mori and Cooper disclose the device discussed above in claim 14, and Mori further teaches of a second receiving means for receiving facsimile data via a public network (network control unit 11, column 10, lines 1 through 26), and data converting means for converting the at least one set of the electronic mail data into facsimile data (column 20, lines 1 through 6), wherein the image forming means forms an image based on the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data (column 9, lines 49 through 62, column 11, lines 38 through 62, and column 14, lines 44 through 50).

Regarding ***claim 16***, Mori and Cooper disclose the device discussed above in claim 14, and Mori further teaches of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (being when "000" is set in the "Subject" field, column 19, line 43 through column 20, line 6), and means for notifying the user of electronic mail data having the high priority (steps 406, 907, and 1207 in Figs. 9, 19, and 24, respectively, whereby the recording and outputting notifies the user, being read in column 14, lines 44 through 50, column 21, lines 1 through 6, and column 23, lines 19 through 10 through 24).

Regarding ***claim 18***, Mori and Cooper disclose the device discussed above in claim 14, and Mori further teaches of means for notifying a user when the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (steps 406, 907, and 1207 in Figs. 9, 19, and 24, respectively, being read in column 14, lines 44 through 50, column 21, lines 1 through 6, and column 23, lines 19 through 10 through 24).

Regarding ***claim 19***, Mori and Cooper disclose the device discussed above in claim 14, and Mori further teaches that the priority determining means determines that a priority is high when corresponding electronic mail title contains a predetermined character (column 19, lines 50 through 67, being "000").

Regarding ***claim 21***, Mori discloses a method of controlling an internet facsimile device (see Figs. 1 and 2, FI1, and FI2) of a receiving party (see Fig. 1, 9, 19, and 24) comprising the steps of receiving electronic mail data attached with a header by the internet facsimile device from a remote internet facsimile device (see Figs. 4A, 4B, and 17), the header including a title (being the "Subject" field), reading the title from the header (steps 402, 903, 1203, in Figs. 9, 19, and 24, respectively, being read in column 14, lines 38 through 45, column 20, lines 62 through 67, and column 23, lines 13 through 18), displaying data (through display part 7, column 9, line 58 through column 10, line 24), determining whether or not the electronic mail has a high priority based on a corresponding electronic mail title (being when "000" is set in the "Subject" field, column 19, line 43 through column 20, line 6), and forming an image based on the electronic mail data which has been determined to have a high priority (column 14, lines 44 through 50, column 21, lines 1 through 6, and column 23, lines 13 through 24), wherein the internet facsimile device prints the image formed based on the electronic mail which has been determined to have a high priority automatically without any instructions from a user (steps 406, 907, and 1207 in Figs. 9, 19, and 24, respectively).

Continuing, Mori teaches that the "Subject" is normally used to display a title (as read in column 19, lines 43 through 54), but Mori fails to specifically teach if the display part 7 actually does display the title that has been received along with the electronic mail data. Cooper discloses

a method of controlling an internet facsimile device (see Fig. 1, column 6, lines 30 through 65) of a receiving party comprising the steps of receiving electronic mail (column 6, lines 30 through 14) attached with a header by the internet facsimile device from internet facsimile device, the header including a title (see Fig. 4, being included in the header of the message, column 9, lines 7 through 39), reading the title from the header (column 6, lines 30 through 42), *displaying the title that has been received along with the electronic mail data (column 7, lines 1 through 53)*, determining whether or not the electronic mail has a high priority based on a corresponding electronic mail title (column 6, lines 16 through 42), and forming an image based on the electronic mail which has been determined to have a high priority (column 6, line 30 through column 7, line 53), *wherein the internet facsimile device displays the received electronic mail title (see Fig. 4, column 9, lines 7 through 49)* and prints the image formed based on the electronic mail which has been determined to have a high priority (via printer 36, seen in Fig. 1, column 6, line 30 through column 7, line 41). Therefore, it would have been obvious to a person of ordinary skill in the art at the invention was made to include the teachings of Cooper in the system of Mori. Mori's system would become more user-friendly with the addition of Cooper's teachings, as an operator or user would be able to see and review messages, and specifically to view the subject of the received messages.

Regarding ***claim 22***, Mori and Cooper disclose the method discussed above in claim 21, and Mori further teaches of determining whether or not the electronic mail belongs to a predetermined group based on the title (being when "000" is set in the "Subject" field, column 19, line 43 through column 20, line 6), and notifying the user of an urgent mail when the electronic mail belongs to the predetermined group (steps 406, 907, and 1207 in Figs. 9, 19, and

24, respectively, whereby the recording and outputting notifies the user, being read in column 14, lines 44 through 50, column 21, lines 1 through 6, and column 23, lines 19 through 10 through 24).

Citation of Pertinent Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kato (U.S. Patent Number 6,618,160) discloses a facsimile system that determines if a received electronic mail should be printed based on a message in the subject field;

Thro *et al.* (U.S. Patent Number 6,147,977) discloses a system that processes messages based on a predetermined priority level; and

Toyoda *et al.* (U.S. Patent Number 5,881,233) discloses a system that reads the header of received electronic mail to determine if the message should be printed (see Fig. 19).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp